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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 18

Application Number: 09/641,896
Filing Date: August 18, 2000
Appellant(s): PINNELL, NIGEL

John M. Harrington (Reg. No. 25,592)
For Appellant

SUBSTITUTE EXAMINER'S ANSWER

This Examiner's Answer is responsive to the Remand dated August 5, 2005 (Paper No. 17). The Board requested a substitute examiner's answer correcting the following deficiencies:

- sole reliance on abstract
- listing of reference not applied

In response, the examiner deleted the reference "GB 23333878" to "SLATER" in the "Prior Art of Record" section. Also, a complete copy of the "Embedded SQL in RPG" reference is provided with an additional supporting section being cited in the Answer.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that group of claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6047268	BARTOLI et al.	4-2000
9526536	LEHER et al.	10-1995
6282523	TEDESCO et al.	8-2001
6073839	MORI et al.	6-2000
EP 0899925	VAN HORNE	3-1999
6247047	WOLFF	6-2001
6330575	MOORE	12-2001
5883810	FRANKLIN et al.	3-1999
EP 0485092	ADAMS	10-1991
5570465	TSAKANIKAS	10-1996
6327578	LINEHAN	12-2001

Cozzi, "Embedded SQL in RPG", 1989

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 8-11, 15-17, 23, 24, 29, 30, 38-45, 56 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6047268 to Bartoli et al.

Bartoli et al. disclose receiving details for the on-line transaction with the vendor from a customer, receiving a nomination of a source of funds for the transaction for the customer (see col. 8, lines 22-26), verifying an availability of funds for a payment amount for the transaction in the nominated source of funds (see col. 7, lines 18-15), generating details of a payment instrument for the transaction corresponding to the transaction details (see col. 8, lines 29-33), providing the customer with the payment instrument details for use in the transaction with the vendor, receiving a request for authorization of the transaction for the customer according to the payment instrument details, authorizing the transaction with the vendor for the customer (see col. 8, lines 33-38). As for storing a record of the payment instrument details, this is an inherent step.

Referring to claim 2, Bartoli et al. disclose receiving information about a payment amount for the transaction (see col. 8, lines 29-38).

Referring to claims 3-5, Bartoli et al. disclose receiving the transaction details by a home banking server (i.e. "billing system") from a computing device of the customer over a network or global network (see col. 7, lines 7-14; col. 3, lines 65-67).

Referring to claims 8-10, Bartoli et al. disclose receiving the nomination of the source of funds by a home banking server from a computing device of the customer over a network or over a global network (see col. 8, lines 22-25, 29-44; col. 3, lines 65-67).

Referring to claim 11, Bartoli et al. disclose verifying the availability of funds for the transaction payment amount in the nominated source of funds by a home banking server (see col. 7, line 18-25).

Referring to claims 15-17, Bartoli et al. disclose generating the details of the payment instrument specific to the transaction, generating the details for the payment instrument consisting of at least the payment amount for the transaction and an unique identification number for the transaction or a fabricated card expiration date (see col. 8, lines 29-33). As per claim17, Bartoli et al. do not expressly state of a fabricated card expiration date, but indicates that the merchant constructs various transaction information including the payment amount, unique ID number and "optional other order data". The examiner presumes that the "optional other data may include the fabricated card expiration date."

Referring to claims 23 and 24, Bartoli et al. disclose providing the customer with the payment instrument details consisting of at least the payment amount for the payment instrument and a unique transaction identification number for the payment instrument or a fabricated card expiration date (see col. 8, lines 29-37). As per claim 24, Bartoli et al.'s system provides the customer with various transaction information including the payment amount, unique

identification number and "optional other data". The examiner presumes that the "optional other data" may include the fabricated card expiration date.

Referring to claim 29 and 30, Bartoli et al. disclose receiving the request for authorization according to the payment instrument details consisting of at least the payment amount for the payment instrument and a unique transaction identification number of the payment instrument and receiving the request for authorization according to the payment instrument details including a predetermined expiry for the payment instrument (see col. 8, lines 30-38). As per claim 30, Bartoli et al.'s system comprising the step of receiving the request for authorization including the payment amount, a unique transaction identification and "optional other data". The examiner presumes that the "optional other data" may include a predetermined expiry for the payment instrument.

Referring to claim 38, Bartoli et al. disclose means for receiving details for the on-line transaction with the vendor from a customer, means for receiving a nomination of a source of funds for the transaction for the customer (see col. 8, lines 22-26), means for verifying an availability of funds for a payment amount for the transaction in the nominated source of funds (see col. 7, lines 18-15), means for generating details of a payment instrument for the transaction corresponding to the transaction details (see col. 8, lines 29-33), means for storing a record of the payment instrument details, means for providing the customer with the payment instrument details for use in the transaction with the vendor, means for receiving a request for authorization of the transaction for the customer according to the payment instrument details, means for authorizing the transaction with the vendor for the customer (see col. 8, lines 33-38; col. 5, lines 45-47).

Referring to claims 39-41, Bartoli et al. disclose means receiving the transaction details further comprises a home banking server (i.e. "billing system"); the home banking server coupled to a computing device of the customer over a network or a global network (see col. 7, lines 7-14; col. 3, lines 65-67).

Referring to claims 42-44, Bartoli et al. disclose means for receiving the nomination further comprises the home banking server coupled to a computing device of the customer over a network or a global network (see col. 8, lines 22-25, 29-44; col. 3, lines 65-67).

Referring to claim 45, Bartoli et al. disclose means for verifying the availability comprises a home banking server (see col. 7, line 18-25).

Referring 56, Bartoli et al. disclose receiving details for the on-line transaction with the vendor from a customer, receiving a nomination of a source of funds for the transaction for the customer (see col. 8, lines 22-26), verifying an availability of funds for a payment amount for the transaction in the nominated source of funds (see col. 7, lines 18-15), generating details of a payment instrument for the transaction specific to the transaction corresponding to the transaction details and consisting of at least the payment amount for the transaction and a unique identification number for the transaction (see col. 8, lines 29-33), providing the customer with the payment instrument details for use in the transaction with the vendor, receiving a request for authorization of the transaction for the customer according to the payment instrument details, authorizing the transaction with the vendor for the customer (see col. 8, lines 33-38). As for storing a record of the payment instrument details, this is an inherent step. As per the unique identification number, Bartoli et al. do not clearly disclose the identification number embedded with a bank identification number; however, Bartoli et al. disclose the merchant constructing

various transaction data including the payment amount, unique identification number and "optional other order data". The examiner presumes that the "optional other order data" may include a unique identification number with embedded with a bank identification number for routing the request for authorization to an authorization server.

Bartoli et al. disclose receiving details for the on-line transaction with the vendor from a customer, receiving a nomination of a source of funds for the transaction for the customer (see col. 8, lines 22-26), verifying an availability of funds for a payment amount for the transaction in the nominated source of funds (see col. 7, lines 18-15), generating details of a payment instrument for the transaction specific to the transaction corresponding to the transaction details and consisting of at least the payment amount for the transaction and a unique identification number for the transaction (see col. 8, lines 29-33), providing the customer with the payment instrument details for use in the transaction with the vendor, receiving a request for authorization of the transaction for the customer according to the payment instrument details, authorizing the transaction with the vendor for the customer (see col. 8, lines 33-38). As for storing a record of the payment instrument details, this is an inherent step. As per the unique identification number, Bartoli et al. do not clearly disclose the unique identification number selected from a characteristic range of number identifiable by a website serve of the vendor as an authenticating number, but, Bartoli et a. disclose the merchant constructing various transaction data including the payment amount, unique identification number and "optional other order data". The examiner presumes that he "optional other data" may include one selected from a characteristic range of number identifiable by a website serve of the vendor as an authenticating number.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 1 above, and further in view of International Publication No. WO 95/26536 to Leher et al.

Bartoli et al. disclose receiving the nomination of a source of funds for the transaction for the customer (see col. 8, lines 22-26). Bartoli et al. do not expressly disclose receiving the nomination of the source of funds from among a plurality of nomination options consisting of at least one of a credit card account, a checking account, and a saving account. Leher et al. disclose receiving the nomination of the source of funds from among a plurality of nomination options consisting of at least one of a credit card account, a checking account, and a saving account (see pg. 40, lines 21-27; pg. 41, line 1-2). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Bartoli et al. include the step of receiving the nomination of the source of funds from among a plurality of nomination options consisting of at least one of a credit card account, a checking account, and a saving account. One of ordinary skill in the art would have been motivated to do this because doing so allows the customer to control his account.

5. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 1 above, and further in view of U.S. Patent No. 6282523 to Tedesco et al.

Bartoli et al. disclose verifying an availability of funds for a payment amount for the transaction in the nominated source of funds (see col. 7, lines 18-25). Bartoli et al. do not expressly disclose reserving funds sufficient for the payment amount in the nominated source of funds for a predetermined expiry period by a home banking server. Tedesco et al. disclose reserving funds sufficient for the payment amount in the nominated source of funds for a predetermined expiry period by a home banking server (see col. 5, lines 48-67). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Bartoli et al. to include the step of reserving funds sufficient for the payment amount in the nominated source of funds for a predetermined expiry period by a home banking server. One of ordinary skill in the art would have been motivated to do this because it ensures available funds for authorized transactions.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 1 above, and further in view of U.S. Patent No. 6073839 to Mori et al.

Bartoli et al. disclose generating details of a payment instrument for the transaction corresponding to the transaction details (see col. 8, lines 29-33). Bartoli et al. do not expressly disclose generating the details of the payment instrument specific to the transaction by a home banking server. Mori et al. disclose generating the details of the payment instrument specific to the transaction by a home banking server (see col. 16, lines 27-29). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Bartoli et al. include the step of generating the details of the payment

instrument specific to the transaction by a home banking server. One of ordinary skill in the art would have been motivated to do this because servers usually mange and maintain the system's resources and files.

7. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 1 above, and further in view of European Patent No. EP 0 899 925 to Van Horne.

Bartoli et al. disclose storing a record of the payment instrument details. Bartoli et al. do not expressly disclose storing the record of the payment instrument details consisting of at least the payment amount for the payment instrument and a unique transaction identification number for the payment instrument or a fabricated card expiration date in a database of at least one of a home banking server and a credit card authorization server. Van Horne et al. disclose storing the record of the payment instrument details consisting of at least the payment amount for the payment instrument and a unique transaction identification number for the payment instrument or a fabricated card expiration date in a database of at least one of a home banking server and a credit card authorization server (see section [0093]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Bartoli et al. to include the step of storing the record of the payment instrument details consisting of at least the payment amount for the payment instrument and a unique transaction identification number for the payment instrument or a fabricated card expiration date in a database of at least one of a home banking server and a credit card authorization server. One of ordinary skill in the art would have been motivated to do this because a database organizes information for quick and easy retrieval.

8. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 24 above, and further in view of U.S. Patent No. 6247047 to Wolff.

Bartoli et al. disclose providing the customer with the payment instrument details for use in the transaction with the vendor (see col. 8, lines 33-38). Bartoli et al. do not expressly disclose providing the customer with the payment instrument details by a home banking server coupled to a computing device of the customer over a network or global network. Wolff discloses providing the customer with the payment instrument details by a home banking server coupled to a computing device of the customer over a network or global network (see col. 8, lines 65-67; col. 9, lines 1-15; abstract, lines 1-3). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Bartoli et al. to include the step of providing the customer with the payment instrument details by a home banking server coupled to a computing device of the customer over a network or global network. One of ordinary skill in the art would have been motivated to do this because the network allows the customer to receive payment instrument details from a remote location.

9. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 30 above, and further in view of U.S. Patent No. 6330575 to Moore et al.

Bartoli et al. disclose receiving a request for authorization of the transaction for the customer according to payment instrument details (see col. 8, lines 33-38). Bartoli et al. do not expressly disclose receiving the request for authorization by a credit card authorization server from a website server of the vendor via a credit card acquirer service of the vendor. Moore et al. disclose receiving the request for authorization by a credit card authorization server from a website server of the vendor via a credit card acquirer service of the vendor (see col. 5, lines 11-

26). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Bartoli et al. to include the step of receiving the request for authorization by a credit card authorization server from a website server of the vendor via a credit card acquirer service of the vendor. One of ordinary skill in the art would have been motivated to do this because this is a common authorization procedure.

10. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 1 above, and further in view of US Patent No. 5883810 to Franklin et al.

Bartoli et al. disclose receiving a request for authorization of the transaction for the customer according to payment instrument details (see col. 8, lines 33-38). Bartoli et al. do not expressly disclose authorizing the transaction if the request for authorization according to the payment instrument details corresponds to the stored record of the payment instrument details. Franklin et al. disclose authorizing the transaction if the request for authorization according to the payment instrument details corresponds to the stored record of the payment instrument details (see col. 9, lines 30-42). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Bartoli et al. to include the step of authorizing the transaction if the request for authorization according to the payment instrument details corresponds to the stored record of the payment instrument details. One of ordinary skill in the art would have been motivated to do this because it provides security by preventing fraud.

11. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 1 above, and further in view of European Patent No. 0 485 090 A 2 to Adams.

Bartoli et al. disclose receiving a request for authorization of the transaction for the customer according to payment instrument details (see col. 8, lines 33-38). Bartoli et al. do not expressly disclose authorizing the transaction upon receiving the request for authorization before a predefined expiry of the payment instrument. Adams et al. disclose authorizing the transaction upon receiving the request for authorization before a predefined expiry of the payment instrument (see col. 6, lines 15-21). One of ordinary skill in the art would have been motivated to do this because it ensures that the payment instrument is valid.

12. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 1 above, and further in view of US Patent No. 5570465 to Tsakanikas.

Bartoli et al. disclose receiving a nomination of a source of funds for the transaction for the customer (see col. 8, lines 22-26). Bartoli et al. do not expressly disclose debiting the nominated source of funds for the payment amount. Tsakanikas discloses debiting the nominated source of funds for the payment amount (see col. 12, lines 6-11). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Bartoli et al. to include the step of debiting the nominated source of funds for the payment amount. One of ordinary skill in the art would have been motivated to do this because it ensures that the merchant is paid for the transaction.

13. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 1 above, and further in view of "Embedded SQL in RPG" by Cozzi.

Bartoli et al. disclose storing payment instrument details. Bartoli et al. do not expressly disclose removing the stored record of payment instrument details. Cozzi et al. disclose removing stored database record (see abstract – "deleting database records" and page 4, *SQL*

Select and Cursor paragraph 4 – "DELETE to destroy the row"). Note. The examiner presumes that the stored database record may contain any data, including a record of payment instrument details. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Bartoli et al. to include the step of removing the stored record of payment instrument details. One of ordinary skill in the art would have been motivated to do this because it creates more storage space (in the database).

14. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 38 above, and further in view of U.S. Patent No. 6073839 to Mori et al.

Bartoli et al. disclose means for generating details of a payment instrument for the transaction corresponding to the transaction details (see col. 8, lines 29-33; col. 5, lines 45-47). Bartoli et al. do not expressly disclose means for generating the details further comprises a home banking server. Mori et al. disclose means for generating the details further comprises a home banking server (see col. 16, lines 27-29). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Bartoli to include means for generating the details further comprises a home banking server. One of ordinary skill in the art would have been motivated to do this because servers usually mange and maintain the system's resources and files.

15. Claims 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 38 above, and further in view of European Patent No. EP 0 899 925 to Van Horne.

Bartoli et al. disclose storing a record of the payment instrument details. Bartoli et al. do not expressly disclose storing the record of the payment instrument further comprises a database

of at least one of a home banking server and a credit card authorization server. Van Horne et al. disclose storing the record of the payment instrument further comprises a database of at least one of a home banking server and a credit card authorization server (see section [0093]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Bartoli et al. to include a database of at least one of a home banking server and a credit card authorization server. One of ordinary skill in the art would have been motivated to do this because a database organizes information for quick and easy retrieval.

16. Claims 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 38 above, and further in view of U.S. Patent No. 6247047 to Wolff.

Bartoli et al. disclose means for providing the customer with the payment instrument details for use in the transaction with the vendor (see col. 8, lines 33-38; col. 5, lines 45-47). Bartoli et al. do not expressly disclose means for providing the customer with the payment instrument details comprises a home banking server coupled to a computing device of the customer over a network or global network. Wolff discloses means for providing the customer with the payment instrument details comprises a home banking server coupled to a computing device of the customer over a network or global network (see col. 8, lines 65-67; c0l 9, lines 1-15; abstract, lines 1-3). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the step disclose by Bartoli et al. to include means providing the customer with the payment instrument comprising a home banking server coupled to a computing device of the customer over a network or global network. One of ordinary skill in the art would have been motivated to do this because the network allows the customer to receive payment instrument details from a remote location.

17. Claims 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. as applied to claim 38 above, and further in view of U.S. Patent No. 6330575 to Moore et al.

Bartoli et al. disclose means for receiving a request for authorization of the transaction for the customer according to payment instrument details (see col. 8, lines 33-38; col. 5, lines 45-47). Bartoli et al. do not expressly disclose means for receiving the request for authorization further comprises a credit card authorization server coupled to a credit card acquirer service of the vendor, or means for receiving comprises a website server of the vendor coupled to the credit card acquirer service of the vendor. Moore et al. disclose means for receiving the request for authorization further comprises a credit card authorization server coupled to a credit card acquirer service of the vendor, or means for receiving comprises a website server of the vendor coupled to the credit card acquirer service of the vendor (see col. 5, lines 11-26). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Bartoli et al. to means for receiving the request for authorization further comprises a credit card authorization server coupled to a credit card acquirer service of the vendor, or means for receiving comprises a website server of the vendor coupled to the credit card acquirer service of the vendor. One of ordinary skill in the art would have been motivated to do this because this is a common architecture for authorization system.

18. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6327578 to Linehan in view of Bartoli et al.

Linehan discloses receiving details for a customer-specified on-line transaction with a vendor by a financial institution server from a computing device of the customer via a network, together with a nomination of a source of funds for the transaction; verifying an availability of

funds for a payment amount for the specific transaction in the nominated source of funds by the financial institution server; generating details of a payment instrument for the specific transaction corresponding to the transaction details consisting at least I part of the payment amount for the transaction, a temporary credit card number by the financial institution server processable via a credit card transaction processing system; storing a record of the payment instrument details in a database by the financial institution server; providing the customer with the payment instrument details for use in the specific transaction with the vendor by the financial institution server, receiving a request for authorization of the specific transaction for the customer according to the payment instrument details from the vendor; and authorizing the transaction with the vendor for the customer if the request for authorization corresponds to the payment instrument details (see col. 4, lines 10-56; col. 9, lines 59-63; col. 10, lines 49-67). Linehan does not expressly disclose nomination of a source of funds for the transaction or a fabricated card expiration date. Bartoli et al. disclose receiving a nomination of a source of funds for the transaction for the customer (see col. 8, lines 22-26) and generating the details of the payment instrument consisting of at least the payment amount for the transaction and a fabricated card expiration date (see col. 8, lines 29-33). As per the fabricated card expiration date, Bartoli et al. indicates that the merchant constructs various transaction information including the payment amount, unique ID number and "optional other order data". The examiner presumes that the "optional other data" may include the "fabricated card expiration date." At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Linehan to include the step of receiving a nomination of a source of funds for the transaction and generating details for the payment instrument consisting of a fabricated card expiration date. One of

ordinary skill in the art would have been motivated to do this because it allows the customer to control his account and prevents unauthorized users form utilizing the cardholder's account.

(11) Response to Argument

Appellant's arguments filed February 20, 2004 have been fully considered but they are not persuasive.

Note. Appellant's brief presents several **new** arguments that were not previously considered.

Rejection of Group I (Claims 1-5, 8-11, 15-17, 23, 24, 29, 30, 38-45, 56 and 57)

Appellant argues that Bartoli et al. require several prerequisites before performing the listed steps including (1) the customer registering with the billing service and (2) the vendor becoming a subscriber to the billing service; whereas, Appellant's invention does not require these prerequisites for implementation. However, the examiner believes that weather or not Bartoli et al. teach additional features should not be considered an issue. The presented claims recite the transition phrase "comprising", which is of the open-type; therefore, the reference must teach **at least** the steps claimed (see MPEP § 2111.03). Although Bartoli et al. may require several preconditions, the reference teaches **at least** the steps of Appellant's invention.

Also, Appellant argues that Bartoli et al. do not teach or suggest generating detail of **a single-use** payment instrument or providing the customer with a single-use payment instrument details. However, Appellant does not disclose **a single-use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of

the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group II (Claims 6 and 7)

Appellant argues that "Bartoli et al. and Leher et al., either separately or in combination with one another, do not recite the required combination of limitations proposing the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the customer's nomination of a source of funds is received for the on-line transaction from among several options, including one or more of a credit card account, a checking account, and a savings account as recited in claims 6 and 7."

As indicated above, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also, as the rejection illustrates, Bartoli et al. disclose receiving the nomination of a source of funds for the transaction (i.e. "a billing method"), and Leher et al. disclose receiving the nomination of the source of funds from among a plurality of nomination options consisting of at least one of a credit card account, a checking account, and a saving account. Leher et al.

reference states that a consumer is presented with a list of accounts (e.g. debit, credit) from which he may make a selection the information is then transferred. This is synonymous to the process of receiving a nomination of the source of funds consisting of credit, checking and saving account.

Group III (Claims 12-14)

Appellant argues that Bartoli et al. and Tedesco et al. do not recite the "method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which a home banking server reserves funds in an account nominated by the customer sufficient for payment for the on-line transaction with the single-use payment instrument as recited in claims 12-14". Notice, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group IV (claims 18 and 46)

Appellant argues that Bartoli et al. and Mori et al. fails to disclose or suggest "the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the details of the single-use payment instrument specific to the transaction are generated for the customer by the home banking server as recited in claims 18 and 46."

Notice, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group V (claims 19-22, 47)

Appellant argues that Bartoli et al. and Van Horne do not disclose "the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the record of the single-use instrument in which the record of the single-use payment instrument details includes the payment amount, a unique transaction identification number, and a fabricated card expiration date, which are stored in the database of either or both of the home banking server and the credit card authorization server as recited in claims 19-22 and 47." Notice, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group VI (claims 25-28 and 49-52)

Appellant argues that Bartoli et al. and Wolff do not disclose "the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the customer is provided with the single-use payment instrument details by a home banking server coupled to the customer's computing device over a global network as recited in claims 2528 and 49-52." Notice, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group VII (claims 31-33 and 53-55)

Appellant argues that Bartoli et al. and Moore et al. do not teach "the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the request for authorization for the on-line transaction with the single-use payment instrument is received by a credit card authorization server from a website server of the vendor via a credit card acquirer service of the vendor coupled to the credit card authorization and website servers as recited in claims 31-33 and 53-55." Notice, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument",

which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group VIII (Claim 34)

Appellant argues that Bartoli et al. and Franklin et al. do not teach "the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the on-line transaction with the vendor is authorized for the customer if the request for the authorization according to the single-use payment instrument details corresponds to the stored record of the single-use payment instrument details as recited in claim 34". Notice, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group IX (claim 35)

Appellant argues that Bartoli et al. and Adams do not teach "the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the transaction with the on-line vendor is authorized for the customer if the request for the authorization is received before the expiry of the single-use payment instrument as recited in claim 35." However, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group X (claim 36)

Appellant argues that Bartoli et al. and Tsakaniskas do not disclose the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the source of funds nominated by the customer for the on-line transaction with the vendor using the single-use payment instrument is debited for the payment amount authorized according to the single-use payment instrument details as recited in claim 36." Notice, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble

for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group XI (Claim 37)

Appellant argues that Bartoli et al. and Cozzi et fail to teach or suggest "the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the record of the details of the single-use payment instrument for the on-line transaction, which are stored, can thereafter be removed from storage as recited in claim 37." Notice, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Group XII (Claim 58)

Appellant argues that Linehan and Bartoli et al. do not teach nor suggest "the method and system for performing an on-line transaction with a vendor using the single-use payment instrument in which the details for the on-line transaction, along with the buyer's selection of one of a number of financial accounts as the source of funds, are received by the financial institution server, which verifies the availability of funds in the account and generates a temporary credit

card number and fabricated card expiration date that is processable via a credit card transaction processing system and provides those details to the customer for use by the customer in the transaction with the vendor as recite din claim 58." However, Appellant fails to teach a **single use** payment instrument within the claimed embodiment, but instead, "a payment instrument", which implies any type of instrument may be applied. Further, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JW
August 18, 2005

Conferees

James Trammell
Supervisory Primary Examiner
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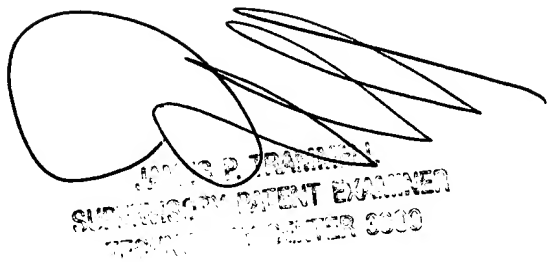

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